



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO. : 10/026,301 CONFIRMATION NO. 8087
APPLICANT : De Billot *et al.*
FILED: December 19, 2001
TC/A.U. : 1616
EXAMINER : S. Mark Clardy
DOCKET NO. : 17396/09015
CUSTOMER NO. : n/a

RESPONSE TO RESTRICTION REQUIREMENT AND ELECTION OF SPECIES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the Office Action of September 7, 2004, which asserted a restriction requirement and an election of species, and is intended to address each and every issue that was raised in that Action. It is being filed concurrently with a Petition for an Extension of Time under 37 CFR §1.136 for one month and a check for the fee for that extension.

Provisional election of claims subject to traverse.

Subject to the traversal discussed below, the Applicant provisionally elects the claims of Group I (claims 76 – 102, 119, 121 and 122).

Election of species and identification of claims that read on the elected species.

The Office has required an election of a single disclosed species for (1) fungicides, (2) herbicides, (3) inoculating fungi (Groups I – III), and (4) plant species

(Group IV only). The Applicant makes the following election of species. Claims that read on the elected species are shown in parenthesis following the elected species.

- (1) fungicide = silthiofam (claims 76 – 80, 88 – 95, 98 - 133)
- (2) herbicide = glyphosate (claims 76 - 133)
- (3) inoculating fungi = *Rhizobium spp.* (claims 76 - 133)
- (4) plant species = soybean (claims 76 - 133)

Traversal of the restriction requirement.

Applicant respectfully traverses the present restriction requirement for the reasons given below and requests that all claims now in the case be searched and examined as a group, or in the alternative, that the claims of Groups I – III be searched and examined as a group.

The prosecution history of this case argues for the search and examination of all present claims as a group. A brief recitation of pertinent parts of that history is as follows:

On March 26, 2003, the Office mailed an Action requiring the election of species, but not indicating any restriction of claims. Prosecution proceeded on that basis.

In its Final Rejection, mailed 26 February 2004, the Office signified certain claims as being allowable if rewritten in independent form incorporating all limitations of all intervening claims.

On 12 April 2004, the Applicant filed a Response After Final Rejection that was designed to comply with all requirements of the final Action. In that Response, claim amendments were made in response to the objections of the previous Action, and those amendments resulted in several claims becoming independent claims – just as the Action had specified.

On 3 June 2004, the Office mailed an Advisory Action refusing to enter the amendments requested because new issues were raised. However, no explanation was provided as to what those issues were.

On 22 June 2004, the Applicant, seeking to advance prosecution of the case, filed an RCE with the claim amendments that had been refused entrance in the Advisory Action.

Now, in the Action mailed 7 September 2004, the Office indicates that the application has been transferred to a new examiner and that the new examiner has issued a requirement restricting claims into four groups.

The Applicant maintains that the present restriction requirement is unjustified because it separates claims that were fully searched and examined as a single group. It is believed that any additional search would not be an undue burden on the examiner.

In the alternative, the Applicant respectfully requests that the Office consider the claims of Groups I, II and III together. A reason for this is that all of the claims in these groups are drawn to methods of protecting plants and are derived from claims that were previously considered to be a single group. The subject matter of each of these claims, therefore, has been searched and examined previously by the Office. It is respectfully maintained that an update of that search at present would not be an undue burden for the examiner.

Request for reconsideration:

It is respectfully requested that the claims be reconsidered in view of the amendments that were submitted with the RCE and after consideration of the reasons for allowability that were submitted with the amendments and be found to be allowable. If one or more of the claims are found to not be allowable, a telephone call to the undersigned would be appreciated in order to resolve any remaining issues.

Respectfully submitted,
Nelson Mullins Riley & Scarborough LLP

Dated: October 22, 2004



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